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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,764	07/31/2003	Yi Li Tsai	FP9618	8455
52981	7590	02/08/2006	EXAMINER	
LEONG C LEI			AGARWAL, MANUJ	
PMB # 1008			ART UNIT	
1867 YGNACIO VALLEY ROAD			PAPER NUMBER	
WALNUT CREEK, CA 94598			3764	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/630,764	Applicant(s) TSAI, YI LI	
	Examiner Manuj Agarwal	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it contains legal phraseology. Terms such as “disclosed and comprises” should be avoided. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Suggested titles include “Massaging Device incorporating delivery of lotion/massaging solution,” “device for massaging lotion/solution into the skin,” “massage device that discharges massaging solution/lotion,” “device for the simultaneous massage and delivery of massaging solution/lotion”

The disclosure is objected to because the Detailed Description of the Preferred Embodiment fails to provide a description of element 27 shown in the drawings.

The specification is objected to under 35 U.S.C. 112, first paragraph for failing to provide an adequate written description. It is unclear how the massaging head would be driven to rotate. Is it an electrical means, or simply mechanical? Is a motor involved?

It is stated that the rotation of the massage head 24 will cause the upward movement required for the dispensing of lotion from the opposite head. Is a means to control the amount of lotion included, or will the entire volume of lotion be dispensed during prolonged use of the massaging head?

What is the criticality of the ring element 23? What purpose does it serve?

How is fixed direction control obtained by the engagement of ratchet teeth face 26 with ratchet teeth face 17? What function do these elements serve?

How is lotion delivered to the sealing cap 13, when the tube 12 is the only structure that is coupled to the lotion container? Element 11 is shown to have an opening into tube 12 that terminates. To the right of tube 12 there is an empty space that is separated from tube 12 by a wall structure. This empty space terminates in the sealing cap 13. Thus it is unclear how the delivery of lotion is achieved.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

It is unclear what structure the prefix "stepped-like" of line 7 entails. The sealing cap 13 is depicted in figs 2 and 3, and a stepped-like structure is not shown.

The positioning screw element is not provided in the inner edge of the lower section of the tubular body (line 10). Rather, it is provided nearly at the center of the apparatus.

The bottom end of the ring element is not mounted to the inner bottom of the massaging end (line 12). Rather, the element is seen to be mounted at the inner top portion.

Lines 19-20 read "when there is no squeezing action of the valve plate restores its position and the sealed outlet." This is an incomplete sentence and it is unclear what is claimed.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the ratchet teeth face of the elastic ring element" in line 15. There is insufficient antecedent basis for this limitation in the claim. Firstly, ratchet teeth were previously only claimed for the screw element. There is not mention of the ring element having ratchet teeth earlier in the claim. Secondly, the ring element is not mentioned to be elastic earlier in the claim. It was simply referred to as the "ring element." The following changes are suggested. (1) The ring element of line 11 should be referred to as an elastic ring element that has a ratchet teeth face, said elastic ring element having a bottom...

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of Tsai, (US 6,793,431) in view of Nakajima et al (US. 5,803,640).

The prior patent claims everything except for a flowing tube that is mounted within the outlet head and connected to the interior of the tubular body. Rather, the fluid is dispensed directly from the interior to the surface via the outlet head. A flowing tube is taught by Nakajima et al. This reference discloses an applicator device that stores and releases a fluid to the surface of the skin. The device includes a conduit, or flowing tube 4 that releases fluid to a sponge like material 5 (col. 12 lines 57-58), a structure that is analogous to the sponge surface layer of the prior art patent. Flowing tube 4 functions to a controlled amount of fluid to the outlet head and apply it to the applicator portion 5. It would have been obvious to leave out details such as a ring element formed of plastic rather than an elastic material and to include the flowing tube in order to provide a more controlled amount of fluid delivered to the skin.

Although the prior art patent does not disclose a massaging function at the opposite head, it is capable of performing a massaging function. The present invention requires a rectangular end 27 to perform the desired massaging function. However, any similar shaped ends are capable of performing a similar massaging effect. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuj Agarwal whose telephone number is (571) 272-4368. The examiner can normally be reached on Mon to Fri 9:00 AM 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen K. Cronin can be reached on (571) 272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuj Agarwal  
Patent Examiner

MA



**Danton D. DeMille**  
**Primary Examiner**